

REMARKS

Upon entry of this amendment, claims 22-28 are all the claims pending in the application.

Claims 29-42 are canceled by this amendment.

Initially, Applicants note that the Examiner still has refused to consider the two co-pending applications listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on November 9, 1999. As discussed previously, Applicants are under no duty to submit copies of these applications.

Nonetheless, in an effort to expedite prosecution, Applicants hereby submit copies of the two applications listed on the PTO-1449 form along with a clean copy of the PTO-1449 form listing only the two applications that were not previously considered. Accordingly, Applicants kindly request that the Examiner consider the two applications listed on the PTO-1449 form and return the initialed and signed PTO-1449 form with the next Office paper.

I. Request to Withdraw Finality of the Office Action mailed October 22, 2003

The Examiner has issued a first Office Action final rejection in the present application and cites to MPEP 706.07(b) in support thereof. Applicants respectfully submit that the finality of the Office Action mailed October 22, 2003 was premature and kindly request that the finality be withdrawn for the following reasons.

On July 28, 2003, an amendment was filed in the present application along with a Request for Continued Examination. In the amendment, the claims were substantially amended to include several new limitations in the form of new claim elements and new functional limitations.

The Office Action mailed October 22, 2003 was a first Office Action on the R.C.E. and was improperly made final by the Examiner. A first Office Action final is proper only when the claims would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application. Such is not the case here. While the Examiner has applied the same art, the grounds of rejection are different due to the claim amendments filed on July 28, 2003.

Specifically, the July 28, 2003 amendment added limitations including: “a user I.D. storage section storing the identification information identifying the user of the data conversion apparatus” and “a ciphering section ciphering the attribute information obtained from the external equipment and the identification information stored in said user I.D. storage section.”

In order to address these new claim elements, it was necessary for the Examiner to change the ground of rejection to now rely on an inherency argument. Thus, as indicated in item 6 on page 3 of the Office Action, the Examiner has modified the grounds of rejection to assert that “a user ID identifying the user of the data conversion apparatus being necessarily, thus inherently, present in order to perform the disclosed authentication” and “ciphering being necessarily, thus inherently, present in order to protect the data in the manner disclosed.”

Thus, at least with respect to the new claim elements discussed above, the Examiner concedes that the applied reference does not explicitly disclose the limitation, but is forced to rely on the new ground of inherency to address the new limitations. Thus, while the Examiner uses the same art, the grounds of rejection are different. Accordingly, the rejection does not meet the requirements set forth in MPEP 706.07(b) for making a first Office Action final.

That is, since it is required that the claims be properly rejected on both (i) the grounds of record and (ii) the art of record in order to properly make a first Office Action final, it is submitted that the finality of the Office Action of October 22, 2003 is premature because a new grounds of rejection was necessary in order to address the claim amendments of July 28, 2003.

Moreover, in addition to the above limitations, the claims were also amended in the July 28, 2003 amendment to add additional functional limitations, e.g., the data format conversion section “adding said ciphered attribute information and identification information to the audio contents.” However, the Examiner has improperly not examined these added limitations on the basis that the functional language “has been deemed merely intended usage of the invention, hence, afforded little patentable weight.” See item 6 on page 3 of the Office Action mailed October 22, 2003. This is improper because, as stated in M.P.E.P. 2173.05 (g):

“A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.”

However, rather than properly evaluating the new functional limitations presented in the amendment of July 28, 2003, the Examiner apparently takes the position that all functional language is intended use. As explained above with reference to MPEP 2173.05(g), such a position is simply incorrect.

Therefore, while the Examiner has applied the same art of record in the present Office Action, this was only possible by changing the ground of rejection to include an inherency

argument and by ignoring functional limitations by improperly deeming the functional limitations as "mere intended usage."

In view of the above, it is submitted that the finality of the October 22, 2003 Office Action was premature and improper, and therefore, Applicants respectfully request that the finality be withdrawn.

II. Claim Rejections under 35 U.S.C. 102(e)

Claims 22-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Imai et al. (U.S. 5,870,467). Applicants respectfully traverse this rejection on the following basis.

Claim 22 recites the feature of an attribute information obtaining section for identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section. Applicants submit that Imai fails to disclose or suggest at least this feature of claim 22.

Imai discloses a data input/output management system for the protection of electronic writing data (see Abstract). As shown in Fig. 1, the system includes an input/output requesting program 11, a data input/output request reception unit 1 for receiving data input/output requests from the program 11, a data input unit 2 for entering data into the program 11 and a data output unit for outputting data from the program 11 (see col. 8, lines 18-34).

When a data input request is received by the input/output request reception unit 1, the data input unit 2 enters the requested data and the protected data judgement unit 3 judges whether the data entered into the program 11 is considered protected data (see col. 8, line 65 - col. 9, line 9). If the data is determined to be protected by the data judgement unit 3, a record of the input is

made in the protected data input recording unit 4 by storing an ID of the requesting program 11 in the protected data input recording unit 4 (see col. 9, lines 42-55). In contrast, if the data is not determined to be protected, then no record is made in the protected data input recording unit 4 (see col. 9, lines 45-48).

When a data output request is received at the input/output request reception unit 1, an output permission judgment unit 5 checks whether the ID of the requesting program 11 is stored in the protected data input recording unit 4 (see col. 10, lines 10-16). If the ID is not stored in the protected data input recording unit 4, then the data is output (see col. 10, lines 16-20). However, if the ID is stored in the protected data input recording unit 4, this implies that the requesting program 11 has previously read protected data, and therefore, further steps are taken to determine whether the data can be output (see col. 10, lines 22-32).

The Examiner alleges that the protected data input unit 4 of Imai corresponds to the attribute information obtaining section as claimed. Applicants respectfully disagree. In particular, Applicants submit that the protected data input unit 4 of Imai fails to identify audio contents of data and obtain attribute information corresponding to the identified audio contents from external equipment via a data transmission/receiving section, as recited in claim 22.

Indeed, Applicants note that the Examiner has not specifically addressed this feature in the present Office Action, but instead, asserts that such functional language is mere intended usage of the invention, and therefore, has not afforded this language patentable weight.

Contrary to the assertion of the Examiner, however, the functional language recited in claim 22 describing particular capabilities of the apparatus is not an “intended use” that can simply be ignored. The MPEP, for example, specifically points out that there is nothing

intrinsically wrong in defining something by what it does rather than by what it is. See MPEP §2173.05(g). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." See MPEP §2173.05(g) (emphasis added).

Functional limitations of an apparatus claim are not significant in determining patentability of an apparatus claim only to the extent that such recitations do not add structural limitations to the claim. The functional limitations in claim 22, however, clearly add structural limitations to the claim because the functional limitations necessitate structure that is capable of performing the recited functions. In other words, the functional recitations in claim 22 require that the claimed data conversion apparatus include structure enabling it to perform the functional limitations. Thus, in order for a prior art reference to meet a functional limitation in an apparatus claim, the prior art structure must inherently be capable of performing that function.¹

Moreover, MPEP §2114, which was cited by the Examiner in the Office Action, provides additional evidence that a prior art structure must inherently be capable of performing the claimed function in order for the prior art structure to meet the claim limitation. As specifically discussed in MPEP §2114, the Federal Circuit held in *In re Schreiber* that the absence of disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of a claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. In other words, because the prior art structure in *Schreiber* was inherently

¹For example, a limitation to "a container for holding therein a liquid in a leaktight manner" is clearly functional in nature, but imparts a structural limitation that distinguishes the container from a colander, which is a container having many holes. That is, the colander is not capable of performing the recited function, and thus, does not meet the limitation.

capable of performing the claimed functional limitations, the Federal Circuit found that the prior art structure anticipated the claim in question.

The Examiner appears to recognize this point by stating in the Response to Arguments section that “if the prior art is capable of performing the intended use, then it meets the claim.” See Office Action at page 5. The Examiner, however, has not followed this required course of analysis by demonstrating that the structure in Imai is capable of performing the functional limitations recited in claim 22. Instead, the Examiner has simply ignored the functional language in explicit contradiction to the guidelines set forth in the MPEP.

As discussed above, claim 22 recites the feature of an attribute information obtaining section for identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section. The Examiner alleges that the protected data input recording unit 4 of Imai corresponds to the attribute information obtaining section as claimed. Accordingly, for the Examiner’s position to be correct, the protected data input recording unit 4 must be inherently capable of performing the functional limitation underlined above.

Applicants respectfully submit that the protected data input recording unit 4 of Imai is not even remotely capable of performing such a function. Rather, as discussed above, the data input recording unit 4 is merely capable of storing an ID of a program that requests data which was determined to be protected by the judgement unit 3 (see col. 8, lines 25-28 and col. 9, lines 10-21 and 43-46).

If the Examiner disagrees and believes that the protected data input recording unit 4 is inherently capable of identifying audio contents of data and obtaining attribute information

corresponding to the identified audio contents from external equipment via a data transmission/receiving section, Applicants respectfully request an explanation from the Examiner as to how the data input recording unit 4 inherently performs this function.

Applicants point out to the Examiner that the question of "inherency" in a prior art reference is a factual issue. *See Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Although extrinsic evidence may be consulted regarding an asserted inherent characteristic, "[s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." *Id.* at 1268 (emphasis added). Moreover, inherency "may not be established by probabilities or possibilities." *Id.* at 1269 (emphasis added).

Applicants submit that the Examiner has not come forward with any factual basis as to why the feature of identifying audio contents of data and obtaining attribute information corresponding to the identified audio contents from external equipment via a data transmission/receiving section must necessarily be present in the protected data input recording unit 4 of Imai. Accordingly, Applicants submit that claim 22 is patentable over Imai and respectfully requests that the rejection be reconsidered and withdrawn.

In addition, claim 22 sets forth the feature of a user ID storage section storing identification information identifying the user of the data conversion apparatus. The Examiner recognizes that Imai does not explicitly disclose such a feature. Nonetheless, the Examiner alleges that a user ID storage section as claimed is inherently present in Imai in order to perform the disclosed "authentication." Applicants respectfully disagree.

In Imai, the “authentication” relates to authenticating an application program, not a user of the system (see Abstract lines 11-18; col. 5, lines 5-7-8; and col. 17, lines 55-58). Indeed, Applicants submit there is absolutely no suggestion in Imai that a user of the system needs to be authenticated. Therefore, as the authentication process in Imai relates solely to application program 106, Applicants submit that the feature of a user ID storage section storing identification information of the user of the data conversion apparatus is clearly not inherent.

Moreover, Applicants note that not all devices require a user to identify themselves by a user ID. Thus, Applicants submit that the feature of a user ID storage section is not necessarily present in Imai, and therefore, is not considered to be inherent. Accordingly, Applicants submit that claim 1 is patentable over Imai and respectfully request that the rejection be reconsidered and withdrawn.

If the Examiner maintains the position that the feature of a user ID storage section storing the identification information identifying the user of the data conversion apparatus is inherent to Imai, Applicants kindly request that the Examiner provide a factual basis as to why such a feature must necessarily be present, so that Applicants may make an informed decision with regard to appeal.

Furthermore, claim 22 recites the feature of a ciphering section ciphering the attribute information obtained from the external equipment and the identification information stored in the user ID storage section. The Examiner alleges that sub hardware 132 (see Fig. 20) inherently performs the function of ciphering attribute information (see Office Action at page 3). Again, Applicants respectfully disagree.

Imai discloses that writing data on a network can be protected by utilizing means of a cipher communication (see col. 18, lines 46-48). The mere disclosure of cipher communication, however, does not address the feature of a ciphering section ciphering the attribute information obtained from the external equipment and the identification information stored in the user ID storage section, as recited in claim 22.

As discussed above, a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." See MPEP §2173.05(g). Accordingly, the feature of ciphering the attribute information obtained from the external equipment and the identification information stored in the user ID storage section cannot merely be ignored by the Examiner.

Applicants respectfully submit that Imai fails to disclose or even remotely suggest such features. Accordingly, Applicants submits that claim 22 is patentable over Imai and kindly requests that the Examiner reconsider and withdraw the rejection.

Further, claim 22 recites the feature of a data format conversion section adding said ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format. The Examiner alleges that output permission judgement unit 5 corresponds to the data format conversion unit as claimed. Applicants respectfully disagree and again note that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

The output permission judgement unit 5 of Imai is responsible for checking whether or not the received data is protected data, and if the data is not protected data, the output permission judgement unit 5 allows the data to be output (see col. 10, lines 10-20). The output permission judgement unit 5, however, is in no way whatsoever capable of adding ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format, as recited in claim 22.

As discussed above, the Examiner alleges that the output permission judgement unit 5 corresponds to the data format conversion section. Additionally, the Examiner alleges that the sub hardware 132 of Imai corresponds to the ciphering section as recited in claim 22. Therefore, as claim 22 recites the feature of a data format conversion section adding said ciphered attribute information, the Examiner is apparently taking the position that the output permission judgement unit 5 (see Fig. 1) adds ciphered attribute information from sub hardware 132 (see Fig. 20). Clearly such a position is untenable. Indeed, in Imai, the output permission judgement unit 5 and the sub hardware 132 are not even disclosed as being operable in the same embodiment.

Based on the foregoing, Applicant submits that claim 22 is patentable over Imai and kindly requests the Examiner to reconsider and withdraw the rejection. If the Examiner maintains the rejection, Applicants request that the Examiner provide a detailed explanation as to how the output permission judgement unit 5 of Imai is capable of performing the claimed function.

Moreover, claim 22 recites the following: "in a case where said data format judging section judges that the received data is not of the superdistribution format, said controller

controls said attribute information obtaining section so as to obtain the attribute information corresponding to the audio contents from the external equipment, and wherein said controller controls said data format conversion section so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus.” The Examiner, however, has not even addressed this feature of claim 22.

Again, it appears as though the Examiner is alleging that this functional language is merely intended usage that can be ignored. As explained above, such a position is incorrect. Applicants submit that in order for Imai to meet this feature of the claim, the apparatus of Imai must inherently be capable of performing the recited function. Applicants respectfully submit that the apparatus of Imai is clearly not capable of performing this function. Accordingly, Applicants submit that claim 22 is patentable over Imai and kindly request that the Examiner reconsider and withdraw the rejection.

Claims 23-28 depend from claim 22 and are therefore considered patentable at least by virtue of their dependency.

In addition, claim 24 recites the feature of a recording section for recording the superdistribution format data. The Examiner alleges that authentication result memory unit 105 corresponds to the recording section as claimed. Applicants respectfully disagree. The authentication result memory unit 105 is responsible for storing the authentication result for each application program 106 but is not responsible for recording superdistribution format data (see

col. 6, lines 22-26). Accordingly, Applicants submit that claim 24 is patentable over Imai and kindly request the Examiner to withdraw the rejection.

Further, claim 24 recites the feature of a charging section for executing a charging operation based on the charge condition of the attribute information. The Examiner alleges that copyright kernel 104 corresponds to the charging section as claimed. Again, Applicants respectfully disagree. The copyright kernel 104 merely authenticates the application program 106. Indeed, Imai does not even remotely suggest that the copyright kernel 104 executes a charge operation based on the charge condition of the attribute information, as recited in claim 24. Accordingly, Applicants submit that claim 24 is patentable over Imai and kindly request the Examiner to withdraw the rejection.

Claim 25 recites the feature of a data transmission/receiving section including a data read-out portion for reading the data out of a disc medium recorded with the data containing the audio contents and includes a network interface which receives the attribute information corresponding to the audio contents from the external server via a digital network . The Examiner alleges that data output unit 6 corresponds to data transmission/receiving section as claimed.

The data output unit 6, however, is only capable of outputting data from the program 11 (see Fig. 1). Accordingly, Applicants submit that the data output unit 6 is not capable of performing the claimed function, and therefore, respectfully submit that claim 25 is patentable over Imai.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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March 16, 2004